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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,609	06/29/2001	Hugh R. Sharkey		7298
23715	7590	03/30/2004		
JOEL R. PETROW SMITH & NEPHEW, INC. 1450 BROOKS ROAD MEMPHIS, TN 38116			EXAMINER PEFFLEY, MICHAEL F	
			ART UNIT 3739	PAPER NUMBER 27

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/895,609

Applicant(s)

SHARKEY ET AL.

Examiner

Michael Peffley

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 41-45, 47-50, 60-65, 67-76 and 81-103 is/are pending in the application.
- 4a) Of the above claim(s) 81-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-45, 47-50, 60-76 and 91-103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>25</u> . | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3739

Applicant's amendments and comments, received February 2, 2004, have been fully considered by the examiner. In particular, claims 41-45, 47-50, 60-65, 67-76 and 81-103 are pending with claims 81-90 being withdrawn from consideration and claims 93-103 being newly added. The following is a complete response to the February 2, 2004 communication.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 103***

Claims 41-44, 47-50 and 91-98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al ('620) in view of the teaching of Colvin ('978).

As shown in Figures 21-25, Baker et al disclose a device which comprises an elongate probe member (100) having proximal and distal portions, the distal portion having a distal surface with first and second electrodes (480 – Figure 23). The electrodes extend across an aperture (409) which is used to either delivery fluids to tissue or aspirate fluid from tissue (col. 28, lines 39+). Leads (not shown) are connected to the electrodes to supply RF energy to the electrodes through the elongate member. While Baker et al disclose a specific crossing pattern for the electrodes (Figure 23), the disclosure states that alternative configurations for the electrodes may be provided (col. 28, lines 58+). Baker et al also teach that the electrodes may extend from the distal surface, be even with the distal surface or be recessed with respect to the distal surface (col. 28, lines 28-32). The only feature not expressly taught by Baker et al is providing the electrodes extending in parallel across the aperture.

Art Unit: 3739

Again, it is noted that Baker et al specifically state that alternative electrode arrangements are contemplated. Further, Colvin ('978) specifically show that it is known to provide an elongate member having RF electrodes extending across the distal surface in parallel.

To have provided the Baker et al device with electrodes extending across the aperture in parallel for the treatment of tissue would have been an obvious design consideration for one of ordinary skill in the art, particularly since Baker et al specifically state that alternative electrode configurations are possible and further since Colvin teach that it is generally known to use such a parallel electrode configuration in an analogous device.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al ('620) and Colvin ('978) and further in view of the teaching of Rydell ('419).

The combination of the Baker et al device with the Colvin teaching of parallel electrodes has been addressed previously. Baker et al teach of various electrode shapes and configurations, but fails to specifically disclose electrodes which are in the shape of a prong.

Rydell discloses an analogous RF. electrosurgical device which includes either one or two electrodes which may form a loop shape (Figure 1) across the distal end of an elongate member. Rydell further teaches that in lieu of the loop member, a prong shaped member (Figure 3) may extend from the distal face of the elongate member.

Art Unit: 3739

To have provided the Baker et al device, as modified by the teaching of Colvin, with a prong shaped electrode in lieu of the loop shaped electrode would have been an obvious design consideration for one of ordinary skill in the art, particularly since Rydell teaches that prong shaped electrodes may be substituted for loop electrodes in a similar device.

Claims 60-65, 67-76 and 99-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al ('620) and Colvin ('978) and further in view of the teaching of Parins ('963).

Again, the combination of the Colvin teaching with the Baker et al device has been addressed. Baker et al fail to specifically teach that the electrodes are active and return electrodes. Rather, Baker et al disclose a proximally located return electrode. Also, Baker et al fail to disclose a prong shaped electrode and an electrode which extends only partially across the lumen. It is again noted that Baker et al teach that various electrode configurations and shapes are contemplated.

Parins ('963) discloses an analogous device which includes an elongate member having a plurality of electrodes extending across a lumen. In particular, Parins teaches that the two electrodes may make up a bipolar pair of electrodes for the bipolar treatment of tissue (col. 4, lines 33-45). Also, Parins show that the electrode may extend partially across the lumen, and may include a prong-shaped electrode (or hook).

To have provided the Baker et al electrodes, as modified by the teaching of Colvin, as a bipolar pair of electrodes for the treatment of tissue would have been an

Art Unit: 3739

obvious modification to one of ordinary skill in the art in view of the teaching of Parins. To have further provided the Baker et al electrodes with an alternative shape and/or configuration, as suggested in the Baker et al disclosure, such as a prong-shaped electrode an/or an electrode extending partially across the lumen would have been an obvious design modification in view of the teaching of Parins.

### ***Response to Arguments***

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

The Woloszko et al ('237) patent is being provided to show another analogous device which includes parallel electrodes extending across an aperture in an elongate delivery member.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

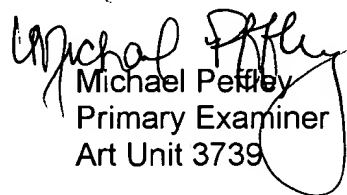
Art Unit: 3739

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (703) 308-4305. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

mp  
March 19, 2004